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Incyte Genomics
3160 Porter Drive
Palo Alto, CA 94304

In re Application of
LAL, Preti, et al.
U.S. Application No.: 10/069,034
PCT No.: PCT/US00/22315
International Filing Date: 14 August 2000
Priority Date: 17 August 1999
Attorney's Docket No.: PF-0731 USN
For: MEMBRANE ASSOCIATED PROTEINS

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COMMUNICATION

This application is before the PCT Legal Office for issues arising under 35 U.S.C. 371.

BACKGROUND

On 14 August 2000, applicants filed international application PCT/US00/22315 which claimed a priority date of 17 August 1999 and which designated the United States.

A Demand was filed with the International Preliminary Examining Authority electing the United States prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 19 February 2002 (17 February 2002 was a Sunday and 18 February 2002 was a national holiday).

On 15 February 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 29 May 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than thirty months from the priority date were required.

On 05 August 2002, applicants filed a response including the \$130 surcharge payment and an executed declaration. A review of the declaration filed on 05 August 2002 reveals a discrepancy between the name given for the ninth inventor on the declaration and that set forth in the published international application. Specifically, the ninth inventor on the international application is identified as Chandra PATTERSON; this inventor is identified as Chandra S. ARVIZU on the declaration.

DISCUSSION

Section 605.04(b) of the MPEP states that:

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

In this case, as noted above the ninth inventor on the international application is identified as Chandra PATTERSON; however, this inventor is identified as Chandra S. ARVIZU on the declaration. This is more than a mere typographical error or phonetic misspelling of the applicant's name.

Accordingly, before the declaration filed on 05 August 2002 can be accepted, applicants are required to file a petition under 37 CFR 1.182, as indicated above. For the petition to be grantable, it must be accompanied by the requisite petition fee of \$130 as well as a statement from the inventor and any other persons having firsthand knowledge of the error which resulted in the discrepancy between the international application and the declaration with respect to the name of the second inventor. Such statement(s) must set forth the specific circumstances as to how and when the error was made and discovered, and must also state that the mistake was an inadvertent error without deceptive intent. In the case where applicant has changed her name, a statement must be signed by this inventor with both names and set forth the procedure whereby the change of name was effected.

CONCLUSION

The declaration filed on 05 August 2002 fails to satisfy 37 CFR 1.497 because, as discussed above, it fails to properly identify the inventors, specifically, the ninth inventor (identified on the international application as Chandra PATTERSON). The declaration therefore can not be accepted in satisfaction of 35 U.S.C. 371(c)(4).

Applicants must file a proper response within **TWO (2) MONTHS** from the mail date of this decision. Any such response should include a petition under 37 CFR 1.182 (including the required petition fee) to resolve the discrepancy in the name of the ninth inventor, as discussed above.

Failure to file a proper response in a timely manner will result in **ABANDONMENT** of the application.

Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

A handwritten signature in black ink, appearing to read 'RM Ross', with a stylized, cursive script.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459